

### **REMARKS**

Claims 14-19 and 34-37 are now pending in the application. Claims 14, 16, 19 and 34-37 have been amended. Claims 20 and 38-42 are withdrawn. Minor amendments have been made to the claims to simply overcome the rejections of the claims under 35 U.S.C. § 112. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

Applicant affirms the election of claims 14-19 and 34-37 under Group I and respectfully requests that claims 20 and 38-42 be withdrawn from further consideration at this time. However, Applicant specifically reserves the right to pursue the subject matter of the non-elected claims in one or more future related applications.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 16, 19 and 36-37 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

In view of the numerous rejections under 35 USC §112, second paragraph as outlined in the Office Action under paragraph 9, Applicant respectfully submits that they have adopted the Examiner's suggested revisions in order to address such rejections. As such, the rejections under 35 USC §112, second paragraph should now be moot.

## **REJECTION UNDER 35 U.S.C. § 102**

Claims 14-15 and 34-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Todt (WO 96/11804). This rejection is respectfully traversed.

In this regard, the Examiner suggests that Todt teaches a method of manufacturing a material for protecting surfaces comprising the steps of providing a shrinkable film 12 having a predetermined shrink response when heat is applied thereto and a nonwoven fabric 14, applying an adhesive to at least one of said film or nonwoven fabric in a predetermined pattern defining first areas bearing said adhesive in said pattern and second areas substantially larger than the first areas extending between the pattern of said first areas bearing said adhesive, and adhering the nonwoven fabric and film together by said adhesive (Figure 1; abstract; p.4, lines 17-22; p. 5, lines 2-18; p. 6, lines 12-25).

As the Examiner is well aware, a rejection under 35 U.S.C. §102(b) can only be maintained if a single reference teaches each and every element of the claims. If there are any differences whatsoever between the reference and the claim(s), the rejection cannot be based on 35 U.S.C. § 102. Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Contrary to the Examiner's interpretation of Todt (WO 96/11804), Applicant respectfully submits that Todt neither teaches nor suggests applying an adhesive to at least one of said film or nonwoven fabric in a predetermined pattern. Todt teaches application of an adhesive to the raised portions of the nonwoven fabric resulting from the randomly arranged fibers thereof; but in no way suggests applying the adhesive in a

pattern. Absent the specific teaching of pattern application of adhesive, the rejection under 102(b) is considered to be improper. Reconsideration is respectfully requested.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 16-19 and 36-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Todt (WO 96/11804) as applied to claims 14 and 34 above and further in view of the collected teachings of Ankuda et al (U.S. Pat. No. 6,638,605) and Woods et al (US RE36,601). This rejection is respectfully traversed.

In this regard, the Examiner suggests that one reading Todt as a whole would have readily appreciated that the reference is not concerned with a particular adhesive applicator. Thus, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to use a gravure roll and doctor blade, as set forth in the present claims, because such is a well known and conventional applicator for applying adhesive to a substrate in a pattern, as taught by the collective teachings of Ankuda (Figures 6-7; column 10, lines 54-60; column 11, lines 24-43 and 43-44) and Woods (Figure 5; column 5, lines 39-56), where the gravure roll allows for the application of adhesive in a desired pattern and the doctor blade removes excess adhesive from the roll to control the amount of adhesive applied to the substrate.

Applicant notes that in order to support a rejection under 35 U.S.C. §103, the Examiner must establish that there is some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability, and, thus, the obviousness, of making the modification to the art suggested by the Examiner.

*Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). That is, although the Examiner may suggest that the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989).

Applicant respectfully submits, particularly in view of the amended claim language of claims 14 and 34 that a rejection under §103(a) is unfounded. By applying the adhesive in a patterned arrangement such that the adhesive occurs substantially along the raised portions of the nonwoven, it should be recognized that a certain percentage of the raised portions of the nonwoven fabric will not include any adhesive and therefore the points of adherence between the nonwoven fabric and the shrinkable film will be far fewer in number than when adhesive is applied over substantially all of the raised portions of nonwoven in a sheet-like fashion. This, in turn, will facilitate the nonwoven bunching up to form cushioning pillows upon shrinking the thermoplastic film to which the nonwoven is adhered as described in the specification.

**CONCLUSION**

Prompt and favorable consideration of this application is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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